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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,299	12/01/2003	Mark L. Anderson	01639.000014.	6104
5514	7590	07/22/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MCCORMICK EWOLDT, SUSAN BETH	
			ART UNIT	PAPER NUMBER
			1655	
DATE MAILED: 07/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,299

Applicant(s)

ANDERSON ET AL.

Examiner

S. B. McCormick-Ewoldt

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 8, 10, 12, 15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 4, 8, 10, 12, 15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The amendment of May 19, 2005 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of Application

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1655.

Claims Pending

Applicant has cancelled claims 2-3, 5-7, 9, 11, 13-14 and 16-18.

Claim Rejections - 35 USC § 102

Claims 1 and 4 remain rejected under 35 U.S.C. 102(b) as being unpatentable by Cals-Grierson (WO 01/82887 A1).

Cals-Grierson (WO 01/82887 A1) discloses using *Vitis vinifera* (grape) extract with the intended use for treating acne ([0022] and [0030]). The composition can be applied topically to the skin ([0034] and [0061]). The extract is obtained from parts of the plant such as the seeds ([0038]). The inactive carriers can be surfactants, thickeners, silica, fatty acids and carbomers ([0069], [0073], [0076] and [0078]) (see also claims 23 and 26). Thus Cals-Grierson meets the limitation of claim 1.

Applicant argues that Cals-Grierson specifically is intended to treat rosacea acne which is not the same thing as acne caused by the bacterium *Propionibacterium acne* as claimed in the present invention.

However, claims 4 and 10 remain rejected because these claims are directed to composition claims, not to methods of treatment. In response to Applicant's argument that *Propionibacterium acne* treats acne and not acne rosacea, a recitation of the intended use of the

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claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 8, 12, 15 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Cui *et al.* (KR 2003073441 A- abstract only).

Cui *et al.* (KR 2003073441 A- abstract only) teach the use of the extract *Vitis vinifera* (grape) against *Propionibacterium acne*. Cui *et al.* also teach topically applying the composition to the affected areas 1 to 3 times a day. Thus, Cui *et al.* teach the limitations of the claims.

Claims 1, 4, 8, 10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Murad (US 5,962,517).

Murad (US 5,962,517) teaches topically applying a grape seed extract for treating acne, which is caused by *Propionibacterium acne* (column 1, lines 60-63; column 7, lines 53-55, 61; column 9, lines 50-55; Table in column 11). Thus, Murad teach the limitations of the claims.

Claim Rejections - 35 USC § 103

Claims 1, 4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cui *et al.* (KR 2003073441 A- abstract only).

Cui *et al.* (KR 2003073441 A- abstract only) disclose the use of the extract *Vitis vinifera* (grape) against *Propionibacterium acne*. Cui *et al.* also teach topically applying the composition to the affected areas 1 to 3 times a day.

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The reference does not specifically teach the type of inactive carrier ingredients claimed by Applicant. The type of inactive carrier ingredients in a composition is clearly a parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the type of inactive carrier ingredients to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of the type of inactive carrier ingredients would have been obvious at the time of Applicant's invention.

Based on this reasonable expectation of success, one of ordinary skill in the art would be motivated to use *Vitis vinifera* in combination with the claimed carriers for the treatment of acne.

From the teaching of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Claims 1, 4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable by Murad (US 5,962,517).

Murad (US 5,962,517) discloses topically applying a grape seed extract for treating acne, which is caused by *Propionibacterium acne* (column 1, lines 60-63; column 7, lines 53-55, 61; column 9, lines 50-55; Table in column 11).

The reference does not specifically teach the type of inactive carrier ingredients claimed by Applicant. The type of inactive carrier ingredients in a composition is clearly a parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the type of inactive carrier ingredients to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of the type of inactive carrier ingredients would have been obvious at the time of Applicant's invention.

Based on this reasonable expectation of success, one of ordinary skill in the art would be motivated to use grape seed extract in combination with the claimed carriers for the treatment of acne.

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From the teaching of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the cited reference, especially in the absence of evidence to the contrary.

Summary

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

Susan D. Coe
7-19-05
SUSAN COE
PRIMARY EXAMINER